

REMARKS

The Office Action of April 8, 2003 cites a new reference and rejects the claims of this application.

Schönhorn 0430548A1 (European patent application) is used to reject claims 1-5 and 11-15. Claim 1 is amended herewith to recite a length of adhesive tape comprising three portions: a leader portion fixed to the core, a foam support portion and a usable tape portion. Claim 1 also requires a foam strip fixed to the tape foam support portion. Schönhorn shows no such structure. Schönhorn has no tape leader portion. Schönhorn has no foam support portion. Rather, Schönhorn describes a foam layer secured to the core by adhesive means (col. 5, lines 1-6). Therefore, claim 1 and the claims dependent thereon are not anticipated by Schönhorn.

Claims 6-10 are rejected as obvious over Schönhorn in view of Martin-Cocher, et al.

As previously argued Martin-Cocher is not analogous art. A prior Office Action states that in order for art to be analogous it “must either be in the field of applicant’s endeavor, or if not, then be reasonably pertinent to the particular problem with which the applicant was concerned.” The Action then asserts “in this case, the prior reference is reasonably pertinent to applicant’s endeavor wherein a material is wrapped around a spool or core and dispensed therefrom.”

Claims 1 and 7 begin “an adhesive tape product”. The title of the application is “ANTI-TELESCOPING ADHESIVE TAPE PRODUCT”. Applicants’ specification describes adhesive tape products and the telescoping problems associated with them. Thus, the field of applicants’ endeavor is adhesive tape products with telescoping problems. Martin-Cocher is not concerned with an adhesive tape product. Rather, it is describing a non-adhesive product, a stretch film, to be used in

industrial packaging applications such as pallet wrapping. The film is stretched different amounts in different zones across its width and is wide. Applicant is dealing with an adhesive coated tape which is from one half inch to three inches wide. Long narrow adhesive tape for use by consumers is not the same field of endeavor as industrial wrapping of pallets or products for shipment.

The other half of the test set forth in the prior Office Action with reference to In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992) is whether the reference is reasonably pertinent to the particular problem with which the applicants are concerned. Applicants are concerned with telescoping in rolls of adhesive tape. This is stated in the title of the invention and made clear throughout the specification. The reference makes no suggestion with respect to this problem and is not at all pertinent with respect to the problem as it is not dealing with long narrow tapes wound upon a core.

Numerous Federal Circuit cases support the distinction made above. In Shatterproof Glass Corp. v. Libbey-Owens Ford Co., 758 F.2d 613, 225 USPQ 634 (Fed. Cir. 1985) it was held that references are within the pertinent art only if they are pertinent to the problems confronting the inventor in the particular application. In King Instrument Corp. v. Otari Corp., 767 F.2d 854, 226 USPQ 402 (Fed. Cir. 1985) cert. denied 475 U.S. 1016 (1986) it was held that a patent for splicing photo typographic film in the printing industry was not within the inventor's field of endeavor or pertinent to his problem with respect to a patent for splicing and winding magnetic tape into a cassette. While both were concerned with tapes, the problems encountered were very much different. The reference dealt with film that was 4 to 6 inches wide while the patent at issued concerned long narrow audio tape. In re Deminski, 796 F.2d 436, 230 USPQ 313 (Fed. Cir. 1986)

restated the two step test discussed above. Prior art is analogous only if the reference is “within the field of the inventor’s endeavor” or is “reasonably pertinent to the particular problem with which the inventor was involved.” Here, neither test is met. It is submitted that Martin-Cocher is not analogous art and is not a proper reference. For this reason, the Section 103 rejection of claims 6-10 should be withdrawn.

Claims 6, 7 (and therefore the claims dependent on claim 7) recite an adhesive tape product comprising a tape core with an outer wall with an outer surface which bulges outwardly at its axial center giving the core a barrel shape; and, a length of adhesive tape wrapped about the core. Schonhorn does not teach a barrel shaped tape core. Martin-Cocher does not teach a barrel shaped tape core. The references, singly or combined do not teach the claimed invention as they are both totally devoid of teachings of one of the recited elements.

There is no teaching to combine Schonhorn and Martin-Cocher. Martin-Cocher does teach a spool which has at least one large diameter zone, small diameter zones and conical sections between them. However, this spool is for temporary (48 hours) storage of a wide, non-adhesive film used in an industrial wrapping operation.

The Office Action states that while Schonhorn fails to disclose a barrel shaped core, “Martin-Cocher et al. teaches that the core has an outer surface bulging outwardly near the core's axial center giving the core a barrel shape (figure 1 number 23) for the purpose of accommodating the elongation of the film and increase film thickness in its margins (col. 4, lines 56-58).” Schonhorn is not using a film having increased thickness in its margins. The Schonhorn tape appears to be of uniform thickness over its width. The Schonhorn tape is not stretched different amounts across its width.

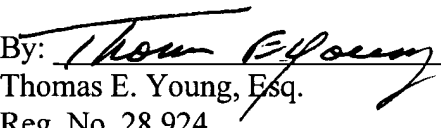
Thus, there is nothing in Schonhorn that teaches one to look to Martin-Cocher, or elsewhere, for a core shape other than cylindrical.

Martin-Cocher teaches nothing concerning adhesive tapes and therefore does not lead one to Schonhorn.

It is respectfully submitted that claims 1-10 as currently amended are allowable over the references cited and an early Notice of Allowance is earnestly solicited. Should the Examiner have any questions or believe further amendment to the claims is required, it is requested that she telephone applicant's attorney at the below stated number.

Respectfully submitted,

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